


<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional)  320037.402 (4P402)	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]  on _____  Signature _____  Typed or printed name _____	Application Number  09/997,402		Filed  11/28/2001
	First Named Inventor  Samir Narendra Mehta		
	Art Unit  2152		Examiner  Duyen My Doan
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <div style="display: flex; justify-content: space-between; align-items: flex-end; margin-top: 20px;"><div style="width: 45%;"><p>I am the</p><p><input type="checkbox"/> applicant/inventor.</p><p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p><p><input type="checkbox"/> attorney or agent of record. Registration number _____</p><p><input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 <u>45,432</u></p></div><div style="width: 50%; text-align: center;"> _____ Signature Philip H. Burrus, IV _____ Typed or printed name  404-797-8111 _____ Telephone number  September 19, 2007 _____ Date</div></div> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			
<div style="display: flex; align-items: center;"><div style="border: 1px solid black; width: 20px; height: 20px; text-align: center; line-height: 20px; margin-right: 5px;"><b>X</b></div><div>*Total of <u>2</u> forms are submitted.</div></div>			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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### **Pre-Appeal Brief Comments**

Issue No. 1: Whether the combination of Jiang et al., US Pat. No. 6,741,853, hereinafter “Jiang,” in view of Tso et al., US Pat. No. 6,088,803, hereinafter “Tso,” and further in view of Krishnamurthy et al., US Pat. No. 6,578,113, herein after “Krish,” teaches all of Applicants’ claimed limitations and thus constitutes a prima facie case of obviousness under 35 USC §103(a).

#### Remarks:

The Office Action (OA) of March 22, 2007 rejected claims 1-20, 22-33, 35-36, 39-41, 43-51, 55-56, 60-71, and 73 under 35 USC §103 as being unpatentable over Jiang in view of Tso.

In response to the OA, Applicants amended the independent claims 1, 30, 45, and 61 to recite the step of determining whether the pre-provisioned content is stored locally or with a trusted third party host, and where the pre-provisioned content is stored with the trusted third party host, retrieving the pre-provisioned content from the trusted third party host following the step of determining whether pre-provisioned content corresponding to the device exists.

The most recent OA, a Final Office Action, mailed June 25, 2007, rejects claims 1-20, 22-33, 35-36, 39-41, 43-51, 55-56, 60-71, and 73 under 35 USC §103 as being unpatentable over Jiang in view of Tso and further in view of Krish. Applicants respectfully traverse this rejection. In traversing the rejection, Applicants reply upon MPEP §2143.03, which states, “To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Applicants respectfully submit that the combination of Jiang, Tso, and Krish fails to teach all of Applicants’ claimed limitations. Specifically, the combination of references fails to teach the step of determining whether the pre-provisioned content is stored locally or with a trusted third party host, and where the pre-provisioned content is stored with the trusted third party host, retrieving the pre-provisioned content from the trusted third party host following the

step of determining whether pre-provisioned content corresponding to the device exists, and delivering the content to a target device without further provisioning.

To begin, neither Jiang nor Tso teaches determining whether the pre-provisioned content is stored locally or with a trusted third party host, and where the pre-provisioned content is stored with the trusted third party host, retrieving the pre-provisioned content from the trusted third party host and delivering it without additional provisioning. Jiang fails to teach retrieving pre-provisioned content from a remote, trusted source. Jiang rather dynamically inspects and adapts all retrieved content, regardless of source. See, e.g., Jiang at col. 6, lines 41-64 and col. 8, lines 8-19. Likewise, Tso fails to teach determining whether pre-provisioned content corresponding to the target device exists, but only teaches detecting whether the pre-provisioned content is locally stored. The OA notes that Tso discloses a transcoding server including a cache memory to store the transcoded version of the content for latter transmission (Tso, col. 6, lines 51-54). Note that FIG. 4 and FIG. 5 of Tso teach the cache memory and the cache storage disposed locally within the networked device. Further, the specification of Tso expressly teaches away from retrieving pre-provisioned content from a remote, trusted, third party hosts in that Tso's disclosure teaches examination of all content, regardless of source.

The most recent OA acknowledges that neither Jiang nor Tso teaches the step of determining whether the pre-provisioned content is stored locally or with a trusted third party host, and where the pre-provisioned content is stored with the trusted third party host, retrieving the pre-provisioned content from the trusted third party host and delivering the content without further provisioning. However, the most recent OA submits that Krish teaches such a step both at col. 1, lines 44-55, and at col. 3, lines 25-34. Applicants respectfully traverse this assertion.

At col. 1, lines 44-55, Krish states the following:

For instance, when the subscriber sends a request for accessing or downloading a particular page in the network, say a page residing at source s.sub.2, the LSP first checks in the proxy cache to determine whether the requested resource is available from the cache without having to transfer the request through the network to the server which is typically more remote. If the resource is available at the cache, the local service provider can transmit the resource back to the requester without the need of forwarding a

request through the network to the server s.sub.2. This avoids unnecessary time delay in processing the subscriber's request.

At col. 3, lines 25-34, Krish states the following:

In accordance with the present invention when the proxy cache receives a request for a particular piece of information, say for example, page 1, it examines whether the cache has a valid copy of the requested resource. If the cache does not have a valid copy then it will forward a request for that resource to the known source of the data, for example server s.sub.1. For purposes of discussion this will be referred to as the primary validation request. The proxy cache will also check its contents for other resources which have been downloaded from server s.sub.1

In both of these passages, Krish only teaches checking a locally stored cache for the content. There is no mention in Krish of checking with a trusted third party host. Krish merely checks to see if the content is stored locally, and if not, polls the source of the content on the network. In contrast to Applicant's invention, when content is not cached locally, Krish merely "constructs a request to the server which is the source for the document and ask for a copy of the document or whether the cached version is valid, step 305." Krish, col. 3, lines 65-68.

This request is constructed regardless of whether the source is trusted or untrusted. There is no mention in Krish of distinguishing between trusted third party hosts and untrusted third party hosts when checking for pre-provisioned content. Applicants note that when determining whether the combination of references teaches all of an applicant's claimed limitations, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Emphasis added.

As none of Jiang, Tso, or Krish teaches determining whether the pre-provisioned content is stored locally or with a trusted third party host, and where the pre-provisioned content is stored with the trusted third party host, retrieving the pre-provisioned content from the trusted third party host and delivering the content without further provisioning, Applicants respectfully submit that the combination of Jiang, Tso, and Krish likewise fails to teach such a step. Applicants respectfully request reconsideration of the rejection

of the independent claims light of these comments. Applicants have amended claim 30, 45, and 61 in like fashion to that of claim 1.

According to MPEP §2143.03, “If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.” *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). As such, Applicants respectfully request reconsideration of claims 30, 45, 61 and their respective dependent claims 31-33, 35, 36, 39-44, 46-51, 55, 56, 58, 60, 62-73 in light of the amendment.

Serial No: 09/997,402  
Examiner: Duyen My Doan  
Art Group: 2152

Reference No.: 320037.402 (4P402)  
Appn. Filed: November 28, 2001  
Applicants: Mehta, Samir Narendra et al.

Issue No. 2: Whether claims 1-29 are indefinite under 35 USC §112.

Remarks:

Applicant does not contest this rejection. Applicant is prepared to amend claim 1 to recite “provisioning the content for the target wireless device” as suggested by the OA, thereby obviating the rejection. Applicants have not done so at this time due to the rules on Pre-Appeal Review Requests. (“The request may not include, or be accompanied by, any proposed amendments.”) Such an amendment will be submitted prior to submission of an appeal brief.